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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,235	08/19/2004	Nicholas Arthur Scott	RR-569 PCT/US	3884
20427	7590	07/05/2007		
RODMAN RODMAN 10 STEWART PLACE SUITE 2CE WHITE PLAINS, NY 10603			EXAMINER AUGUSTIN, EVENS J	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 07/05/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/505,235

Applicant(s)

SCOTT, NICHOLAS ARTHUR

Examiner

Evans Augustin

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,5-28 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5-28 and 31-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This is in response to an amendment filed on 16 March 2007. Claims 1, 2, 29 and 60 have been cancelled. Claims 33-36 have been added. Claims 3, 5-28, 31-32 and 33-36 are pending. Claims 3, 5-28, 31-32 and 33-36 have been examined.

Response to Arguments

2. Applicant's arguments with respect to claims 3, 5-28, 31-32 and 33-36 have been considered but are moot in view of the new ground(s) of rejection.

Claim Interpretation

3. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art.

4. It should also be noted that, in the office action that:

A. Items in the rejection that are in quotation marks are claimed language/limitations

B. Functional recitation(s) using the word "for" or other functional terms (*e.g.* "the device displaying articles of merchandise or representations thereof for selection by a customer upon activation of the device" as recited in claim 35) have been considered

but given less patentable weight¹ because they fail to add any steps and are thereby regarded as intended use language. To be especially clear, the Examiner has considered all claim limitations. However the A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 5-28, 31-32 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Planke (U.S 5902984), in view of Recktenwald et al. (U.S 6439345).

7. As per claims 3, 5-28, 31-32 and 33-36, Planke discloses an invention relates to a system for the sale of consumer goods, where the purchaser of an article at the place of purchase collects one or more non-validated card symbols of the article, where data carried on the symbol of the

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight).

article are read and registered, where such data are converted to a price for the article which is paid by the purchaser of the article, where the purchaser of the article receives a validated symbol of the article, and where the article is dispensed to the purchaser at a dispensing location in return for his/her depositing the validated symbol of the article. The computer system includes:

- A. An optically readable card with data containing the item to be purchased in the form of a serial number (column 2, lines 12-16). The uniqueness of the serial number implies that is generated serially.
 - B. A merchandise dispensing unit to dispense merchandise in accordance with the corresponding serial number (serially generated transaction code)(column 2, lines 17-18)
 - C. A checkout unit (cash register), where the optically readable card is validated (column 2, lines 25-30)
 - D. A comparator unit to reconcile the information received by dispensing unit (column 4, lines 26-29)
 - E. The type of information in the card can be a bar code and magnetically readable code (column 3, lines 42-43), or EAN code (column 5, lines 41)
 - F. After the card is validated at the check out unit, the validation signal is sent to the merchandise dispenser to be able to recognize and accept the validated card before dispensing the merchandise (column 4, lines 21-50, column)
 - G. The ability to transmit the validation signal from the check out unit to the merchandise dispenser via a connection (column 4, lines 44-45, figure 1, items 9 and 15)
-

H. The check out unit includes a scanner or a bar code reader (column 3, lines 49-51)

8. Planke did not explicitly describe a method/system in which the initial non-validated card/token/ticket is dispensed by a mechanism such as dispensing unit. However, Schlamp describes an invention that relates to a system for the sale and delivery of products. According to Schlamp, describes a mechanism in which a user selects products to be purchased (col. 2, lines 60-67). The mechanism can print a bar coded receipt , used by the cash register to validate the receipt and give the user a validated token/card for the user to use to actually get the item (col. 3, lines 1-10). According to Schlamp, the selection item contains a keyboard (col. .2, line 50), which suggest that it would also be used as an entry device.

9. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to combine Planke's invention of a merchandise dispenser that validates/reads validation card/token/ticket with Schlamp's invention that relates that relates to a system for the sale and delivery of products.

10. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the two inventions because it would allow the customer the flexibility to select and print a token for the item that he or she chooses.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. The USPTO would strongly urge applicant to look into reference number US 6439345, as it is very pertinent to applicant's invention.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 10 to 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779.

/ Evens J. Augustin/
Evens J. Augustin
June 24, 2007
Art Unit 3621

KAMBIZ ABDI
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Kambiz Abdi', written over a horizontal line.